

Notice of Allowability

Application No.

09/938,894

Examiner

Kaj K. Olsen

Applicant(s)

REEL ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment of 7-19-2005.
2. ☒ The allowed claim(s) is/are 26-38.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 4/18/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows: On page 11, starting at line 30, the text "Attorney Docket No. 5010-001 [Kilyk & Bowersox] and 4573/4660 [Applied Biosystems]" was deleted and replaced with --09/938,947, now US Patent 6,890,409--.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: Claim 26 is drawn to a system comprising, among other elements, two coextensive elongated electrically-conductive members wherein a portion of a first is retained by an electric gradient between the members wherein the members are outside of a sample holder. This claim was previously rejected over Papp and Chang as having structure that read on the defined structure of the claims. However, claim 26 now explicitly recite the presence of a sample being retained by the electrical gradient when the members are outside of a sample holder. Not only do Papp and Chang not disclose any sample being retained on the members, the examiner does not believe they would be capable of having sample retained based on their disclosures and the examiner's understanding of the instant invention. In particular, although Papp would inherently possess an electrical gradient,

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that gradient would have been a short-lived pulsed gradient (i.e. with a 5 millisecond exponential decay). See col. 6, ll. 17-22. Chang similarly only discloses pulsing the AC power for short time periods (40 μ s) to effect the desired cell fusion. See col. 6, ll. 16-19. Applicant discloses on p. 10, ll. 1-6 that the retention or trapping of the instant invention can be reduced or ceased by changing the field strength, frequency, or both. From this the examiner presumes that in the absence of the established gradient, the sample trapping would also cease. Hence the devices of Papp and Chang would be unable to retain sample between the members when the members are outside of the sample holder because Papp and Chang don't disclose establishing an electrical gradient when the members are outside of the sample holders, and Papp and Chang only disclose millisecond or microsecond lengths of gradient, which would not have been sufficient time to remove the members from the sample holder with the electrical gradient still intact. For this reason, Papp or Chang do not disclose this new structural limitation, nor would Papp or Chang have been capable of meeting this new limitation.

3. Claim 29 is similarly allowable over the prior art for the reasons set forth in the discussion for claim 26.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (571) 272-1344. The

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examiner can normally be reached on Monday through Thursday from 5:30 A.M. to 3:00 P.M. and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 23, 2005



KAJ K. OLSEN
PRIMARY EXAMINER